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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,413	01/08/2001	Jason Thomas	25969-1	5445
24256	7590	11/05/2004	EXAMINER	
DINSMORE & SHOHL, LLP 1900 CHEMED CENTER 255 EAST FIFTH STREET CINCINNATI, OH 45202			SHAH, ANKEETA	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,413

Applicant(s)

THOMAS, JASON

Examiner

Ankeeta Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/08/2001.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

.DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 line 1 "maybe" is indefinite.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6 and 9-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Fite at al. (Fite hereafter, US PAT 6,467,684).

Fite discloses an electronic commerce card:

Re claim 1: An electronic commerce card, comprising: a fixed non-renewable amount of currency (i.e. pre-paid one-time use only card, see abstract) associated with a remote account (i.e. customer account, see column 3 lines 66-67) operable to be debited and operable to be transferred to a second remote account (i.e. merchant account, see column 3 lines 66-67); and a unique identification key (i.e. unique identification number, see abstract) operable to identify the remote account and be used electronically to purchase goods or services (i.e. card is for paying for purchases over an electronic or computer network, see abstract)

Re claim 2: Fite further discloses: a computer readable strip on the card operable to communicate the identification key (i.e. readable memory on the card which is obtained in a magnetic strip or other machine readable, see summary of invention column 2 lines 7-8)

Re claim 3: Fite further discloses: wherein the identification key is provided in place of a credit card number for an electronic transaction (see abstract column 2)

Re claim 4: Fite further discloses: wherein the identification key is not traceable to a user of the card (i.e. it provides anonymity see column 3 lines 15-25)

Re claim 5: Fite further discloses: wherein the key may be provided anonymously by a user to acquire one or more of the goods or services (i.e.

the customer may provide an optional personal identification number, see column 3 lines 39-52).

Re claim 6: Fite further discloses: wherein the card is acquired for a price equal to or greater than the fixed non-renewable amount of currency (i.e. the purchasing value of the card is at lease equal to or larger than the purchase price, see summary column 2 lines 1-6).

Re claim 9: Fite further discloses: A method of distributing electronic cards, having executable instructions(i.e. the card provides executable function, see column 6 lines 39-44), comprising associating a key with a fixed non-renewable amount of currency (i.e. pre-paid one-time use only card, see abstract); providing the key to a merchant; and distributing the key to a consumer.

Re claim 10: Fite further discloses: wherein the key is provided to the merchant on a plastic card (see column 2 line 66)

Re claim 11: Fite further discloses: wherein the key is provided as a number electronically delivered to the merchant. (i.e. the customer can provide the identification number on the merchant website, column 4 lines 44-48).

Re claim 12: Fite further discloses: further comprising: using the key by the consumer to purchase goods or services (i.e. A pre-paid card system for

purchasing products or services and each card having a unique identity number associated, see column 5, lines 59-60)

Re claim 13: Fite further discloses: wherein the key is used via the Internet in an electronic transaction (see abstract, lines 1-2).

Re claim 14: Fite further discloses: wherein the electronic transaction occurs with anonymity of the consumer (see column 1, lines 15-25 and column 4 lines 59-61)

Re claim 15: Fite further discloses: further comprising: debiting the currency when the key is used by the consumer to purchase goods or services (see column 4 lines 26-31).

Re claim 16: Fite further discloses: method of using electronic cards, having executable instructions, comprising: acquiring a key associated with a fixed non-renewable amount of currency; and using the key to purchase goods or services (i.e. the card has a magnetic strip which is read only memory which contains the identity number. The card reader reads the memory on the card such as swipe slot for receiving the card and reading the card identification number from the magnetic strip, see column 3 lines 10-19).

Re claim 17: Fite further discloses: further comprising: transferring the key electronically to a merchant instead of a credit card number (i.e. customer can

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provide the identification number on the merchant website (i.e. electronically)
(see column 4 lines 44-48).

Re claim 18: Fite further discloses: further comprising: preserving the
anonymity of a consumer using the key to purchase the goods or services
(see column 4, lines 57-61).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148
USPQ 459 (1966), that are applied for establishing a background for determining
obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Re claim 7 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fite in view of Downing et al. (Downing hereafter, US PAT 5963647)

Re claim 7: Fite does not show: wherein the key is operable to be distributed to a user on a receipt. Downing discloses that the concept of receiving a receipt that includes a system-generated security code (see column 3 lines 22-23). Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the card of Fite by adapting the teaching of Downing to further prevent fraud by separating the card and the identification key.

Re claim 19: Fite does not show: the electronic cards wherein the key is acquired on a receipt by a consumer. Downing discloses that the concept of receiving a receipt that includes a system-generated security code (see column 3 lines 22-23). Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the card of Fite by adapting the teaching of Downing to further prevent fraud by separating the card and the identification key.

5. **Re claim 8 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fite in view of Tsiounis et al. (Tsiounis hereafter, US 2001/0032878)

Re claim 8: Fite does not show: wherein the key is operable to be distributed to a user via an electronic email. Tsiounis discloses the sending an email to the merchant with the Identification number (see background, column 2, [0012]). Thus, it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the card if Fite by adapting the teaching of Tsiounis to further enhance the delivery of the identification key.

Re claim 20: Fite does not show: wherein the key is acquired electronically by a consumer. Tsiounis discloses the sending an email to the merchant with the Identification number (see background, column 2, [0012]). Thus, it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the card if Fite by adapting the teaching of Tsiounis to further enhance the delivery of the identification key.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ankeeta Shah whose telephone number is (703) 305-0853. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SOUGH HYUNG can be reached on (703) 308-0505. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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